

REMARKS/ARGUMENTS

I. Status of the Claims

Claims 1-8, 10, 11, 47-51, 61 and 65 are pending.

Claim 65 stands rejected under 35 USC §112, 2nd paragraph as indefinite

Claims 1-8, 10, 11, 47-51, 61 and 65 stand rejected under 35 U.S.C. §112, first paragraph, written description.

Claims 1-8, 10, 11, 47-51, 61 and 65 stand rejected under 35 U.S.C. §112, first paragraph, enablement.

Claims 2, 4-5, 7 and 11 stand rejected under 35 U.S.C. §102(b) as anticipated by, or in the alternative under 35 U.S.C. §103 as obvious over, Mahairas et al., Locus AQ495547.

Finally, the Patent Office issued a provisional double patenting rejection of claims 1-8, 10, 11, 47-51, 61 and 65 over copending Application No. 10/449,140.

Claims 2, 3, 11 and 65 have been canceled in the instant response

Claims 1, 4, 47, 49, 50 and 61 have been amended in the instant response. Support for the amendment to claim 1 is found throughout the specification as filed, for example in the Sequence Listing, in Figure 1 and in the description of Figure 1. Applicants submit that the amendments do not incorporate any new matter.

II. Response to the Rejection of Claims 1-8, 10, 11, 47-51, 61 and 65

Under 35 U.S.C. §112, Second Paragraph

The Patent Office rejected claim 65 under 35 U.S.C. §112, second paragraph, as indefinite. It is the Patent Office's position that claim 65 is "lacking sufficient method steps or elements. There is nothing recited in the claim or claim 5, from which it now depends, that would allow production of an $\alpha 2$ subunit." *Office Action*, page 2.

Applicants submit claim 65 is definite as written and that the recitation of additional steps is not required. However, in an effort to advance prosecution application have canceled claim 65. Accordingly, applicants respectfully request that the rejection of claim 65 under 35 U.S.C. §112, second paragraph, be reconsidered and withdrawn.

III. Response to the Rejection of Claims 1-8, 10, 11, 47-51, 61 and 65

Under 35 U.S.C. §112, First Paragraph, Written Description

The Patent Office rejected claims 1-8, 10, 11, 47-51, 61 and 65 under 35 U.S.C. §112, first paragraph, as not complying with the written description requirement. Applicants traverse the rejections and address each in turn.

A.

The Patent Office states “[c]laims 1-3, from which all other claims depend have been amended to add specific wash conditions. Applicants point to pate 145 of the specification for support for the amendments. However, the specification merely states that the washes were performed *for* 20, and 10 minutes respectively, no for up to 20 or 10 minutes.” *Office Action*, page 3. The Patent Office states this is a new matter rejection.

Although applicants disagree with the Patent Office’s analysis, in the interest of advancing prosecution applicants have removed the subparts of claim 1 that recite hybridization conditions. Claims 2, 3, 11 and 65 have been canceled.

B.

The Patent Office continues, “[a]dditional new matter is found in the recitation that substitutions are in the region extending from residue 25 to the C-terminus of SEQ ID NO:1.” *Id.* Applicants traverse the rejection and submit the following comments. Again, the Patent Office states this is a new matter rejection.

Although applicants disagree with the Patent Office’s analysis, in the interest of advancing prosecution applicants have canceled claims 2, 3, 11 and 65. Applicants note that claim 3 recited the language objected to by the Patent Office.

In light of the above and the claim amendments and cancellations, applicants respectfully request that the rejection of claims 1-8, 10, 11, 47-51, 61 and 65 under 35 U.S.C. §112, first paragraph, written description, be reconsidered and withdrawn.

IV. Response to the Rejection of Claims 1-8, 10, 11, 47-51, 61 and 65

Under 35 U.S.C. §112, First Paragraph, Enablement

The Patent Office rejected claims 8, 10, 11, 47-51, 61 and 65 under 35 U.S.C. §112, first paragraph, as not enabled. Applicants traverse the rejections and address each in turn.

A.

The Patent Office states “the specification, while being enabling for a nucleic acid of SEQ ID NO:2 or that encodes SEQ ID NO:1, does not reasonably provide enablement for the breadth of the claims, which encompass numerous fragments, derivatives, etc. of such.” *Office Action*, page 3. It is the Patent Office’s position that “[a]lthough portions of the claims have been amended, they remain extremely broad; note that the washes have no minimum length of time, such that substantial non-specific hybridization is allowed.” *Office Action*, page 3-4.

Applicants note that claim 1 no longer recites hybridization conditions and that claims 2 and 3 has been canceled. Applicants submit that these amendments and claim cancellations overcome the Patent Office’s rejection.

B.

The Patent Office further contends that that the rejected claims contain “subject matter which was not described in the specification in such as way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.” *Office Action*, page 5. With respect to the hybridization conditions recited in the claims, the Patent Office continues, “there is no minimum time of washing, such that the recited conditions are not stringent.” *Office Action*, page 5.

Although applicants disagree with the Patent Office’s position, the subparts of claim 1 reciting hybridization conditions have been removed in the instant response. Claims 2 and 3 have been canceled.

In light of the above and the claim amendments and cancellations, applicants respectfully request that the rejection of claims 1-8, 10, 11, 47-51, 61 and 65 under 35 U.S.C. §112, first paragraph, enablement, be reconsidered and withdrawn.

V. Response to the Rejection of Claims 2, 4-5, 7 and 11

Under 35 U.S.C. §102(b) or Alternatively Under 35 U.S.C. §103(a)

The Patent Office rejected claims 2, 4-5, 7 and 11 under 35 U.S.C. §102(b) as anticipated by, or alternatively under 35 U.S.C. §103(a) as obvious over, Mahairas, Locus AQ495547. Applicants traverse the rejection and submit the following comments.

The Patent Office states that “because [Locus AQ495547] would inherently hybridize to that of SEQ ID NO:2 and encode a polypeptide with at least one activity of the polypeptide encoded by SEQ ID NO:2, it meets the limitations of claim 1, and given the formulae for calculating percent identity in the specification (page 20, line 30) also meets the limitations of claim 2, and is truncated, meeting the limitations of claim 3.” *Office Action*, page 6.

Applicants have amended claim 1 to remove the recitation of hybridization conditions. Claims 2 and 3 have been canceled.

Applicants submit that the amendments to claim 1 and the cancellation of claims 2 and 3 overcomes the Patent Office’s rejections. Accordingly, applicants respectfully request that the rejection of claims 2, 4-5, 7 and 11 under 35 U.S.C. §102(b) or alternatively under 35 U.S.C. §103(a) be reconsidered and withdrawn.

VI. Response to the Provisional Double Patenting Rejection

The Patent Office provisionally rejected claims 1-8, 10, 11, 47-51, 61 and 65 over claims 100-116 of copending U.S. Patent Application Serial Number 10/449,140 on the grounds of non-statutory obviousness-type double patenting.

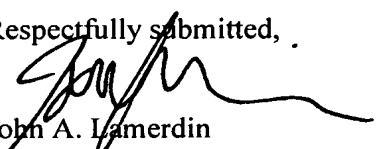
Applicants acknowledge the Patent Office’s provisional rejection. As no claims have yet been allowed in either the instant application or in U.S. Patent Application Serial Number 10/449,140, applicants will address the provisional rejection upon notification of allowable claims in either application.

VII. Conclusions

Applicants submit that the claims are in condition for allowance. Accordingly, applicants respectfully request that the rejections of record be reconsidered and withdrawn, and a Notice of Allowance issued.

If any small matter remains outstanding after the Examiner has reviewed the amendments and remarks presented herein, the Examiner is respectfully requested to telephone the undersigned attorney at the telephone number provided below to resolve any such matter.

Respectfully submitted,



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